

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. APPLICATION NO. 09/614,592
ATTORNEY DOCKET NO. Q60082

REMARKS

Claims 1-10 have been examined on their merits.

The Patent Office objects to claims 2-6, 8 and 10 as being dependent upon a rejected base claim. Applicant thanks the Patent Office for indicating that claims 2-6, 8 and 10 would be allowed if rewritten in independent form.

Applicant herein adds new claims 11-18. New independent claim 11 is based on the combination of claims 1 and 4, which the Patent Office has indicated as being allowable. Applicant submits that new claim 11 is in condition for allowance, and further submits that new claims 12-18 are allowable as well, at least by virtue of their dependency from new claim 11.

Claims 1-18 are all the claims presently pending in the application.

1. Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* (U.S. Patent No. 6,069,912) in view of Ono (U.S. Patent No. 6,272,167). Applicant traverses the rejection of claim 1 for at least the reasons discussed below.

The combination of Sawahashi *et al.* and Ono fails to teach or suggest at least a weighted-mean-value processor that weights and adds the correlation signals output from correlation processors, stores the weighted and averaged signals as interim results, and then averages a plurality of interim results stored over a certain time period, as recited in claim 1. The averaging of the weighted and added signals of the combination of Sawahashi *et al.* and Ono is performed only once, and there is no teaching or suggestion in the combination that interim calculated results are saved to be averaged with the next set of interim calculated results.

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At best, the combination of Sawahashi *et al.* and Ono discloses a path search circuit that comprises a weighted-mean-value processor that weights and adds correlation signals output from a plurality correlation processors, and then level adjusts the weighted and added correlation signals. There is no teaching or suggestion of averaging weighted and added correlation signals are saved as interim results and averaged with other interim results saved over a predetermined period of time in either Sawahashi *et al.* or Ono. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Applicants submit that one of skill in the art would not be motivated to combine the two references. Both Sawahashi *et al.* and Ono lack any teaching about the desirability of a weighted-mean-value processor that weights and adds correlation signals and then saves the interim results, and averages the interim results saved over a predetermined period of time. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Sawahashi *et al.* and Ono fails to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicants submit that claim is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 1.

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2. Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* in view of Ono and in further view of Dobbins *et al.* (U.S. Patent No. 5,730,272). Applicant traverses the rejection of claims 7 and 9 for at least the reasons discussed below.

Claims 7 and 9 depend from independent claim 1, and therefore incorporate all of the features thereof. Applicant submits that Dobbins *et al.* fail to cure the deficiencies of the combination of Sawahashi *et al.* and Ono as discussed above regarding claim 1. Thus, Applicant submits that claims 7 and 9 are allowable at least by virtue of their dependency from independent claim 1, and respectfully requests that the § 103(a) rejection of claims 7 and 9 be withdrawn.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 9, 2005